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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,086	01/10/2001	Richard L. Sandt	AVERP2822US	7421

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EXAMINER

GREEN, BRIAN

ART UNIT

PAPER NUMBER

3611

DATE MAILED: 06/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicant No.

09/758,086

Applicant(s)

SANDT ET AL *N*

Examiner

Brian K. Green

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 February 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 31-40 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-19 is/are allowed.
- 6) ☒ Claim(s) 20-29 is/are rejected.
- 7) ☒ Claim(s) 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 31-40 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

Claims 14-18 have been considered since they depend on allowable generic claim 1.

### ***Drawings***

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on Feb. 3, 2003 have been approved.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the radio frequency identification device and the tie layers defined in claims 10 and 19 must be shown in the elected embodiment figures or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3611

Claim 28 fails to further limit claim 20, i.e. claim 20 now includes all of the structure defined in claim 20.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20, 21, 23, 28, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Beinert et al. (U.S. Patent No. 5,595,810).

Beinert et al. Shows in figure 1a a facestock (plastic film), heat-activatable layer (melt adhesive layer) adhered to the “lower” surface of the facestock, a laminating adhesive (adhesive layer) overlying the facestock, and a carrier layer (separation paper) adhered to the laminating adhesive. The separation paper is considered to be the top layer in the Beinert et al. patent and the carrier layer is considered to be the bottom layer. In regard to claim 23, the heat-activatable layer of Beinert et al. is a heat-activatable adhesive. In regard to claim 28, Beinert et al. shows in figure 1a that the layer of ink or graphics (Decorative layer) is on the lower surface of the heat-activatable layer. In regard to claim 29, as broadly defined, the “Decorative Layer” of Beinert et al. is considered to be the “detach layer”.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3611

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beinert et al. (U.S. Patent No. 5,595,810).

In regard to claim 22, Beinert discloses the idea of making the facestock (plastic film) out of one thick layer. Beinert does not disclose the idea of making the facestock out of two layers. It would have been an obvious matter of design choice to make the facestock out of two layers instead of one since the applicant failed to define any advantage to making the facestock out of two layers and making the facestock out of a single layer as taught by Beinert would work equally well. In regard to claims 24-27, Beinert does not disclose the use of the specific materials disclosed in these claims. However, the materials defined are conventional and it would have been an obvious matter of design choice to make the layers out of the materials defined since the applicant failed to define any advantage to making the materials out of the materials defined and the materials used by Beinert would work equally well.

#### ***Response to Arguments***

Applicant's arguments filed Feb. 3, 2003 have been fully considered but some of the arguments are not persuasive.

The applicant argues that since claim 28 was not rejected by Beinert et al. (U.S. Patent No. 5,595,810), and the applicant added the subject matter of claim 28 to independent claim 20, claim 20 should now be allowable over Beinert et al. The examiner disagrees since claim 28 was rejected under 102(b) with regard to the Beinert et al. patent. Therefore, the addition of claim 28 to claim 20 still does not make claim 20 allowable over the Beinert et al. patent.

Art Unit: 3611

The applicant argues that since an RFID is undoubtedly an identifying indicia the indicia 710 in figures 7a-7c, indicia 806 in Figs. 8a-8b, and indicia 908 and 925 in figs. 9a-9c are all identifying indicia. Therefore, the RFID is shown in the figures. The examiner disagrees since the applicant fails to define in the specification that the RFID is an identifying indicia and further fails to indicate that any of the indicia (710,806,908,925) can be the RFID. As defined by the applicant in the specification, page 11, lines 20-22, it appears that the RFID is an additional element which the applicant has failed to show in the drawings.

Claims 1-19 are allowed.

Claim 30 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3611

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3597 for regular communications and (703) 305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-2168.

  
BRIAN K. GREEN  
PRIMARY EXAMINER

Bkg  
May 23, 2003